

O/0634/24

TRADE MARKS ACT 1994

CONSOLIDATED PROCEEDINGS

**IN THE MATTER OF TRADE MARK REGISTRATIONS UK439845, UK477782, UK477783, UK583123,
UK1582199, UK2006310, UK2012466**

AND

INTERNATIONAL TRADE MARK IR1174169

IN THE NAME OF SAIC MOTOR CORPORATION LIMITED

AND

APPLICATIONS 504611-18

BY MORRIS COMMERCIAL LIMITED

TO REVOKE THE TRADE MARKS FOR NON-USE

AND

AND IN THE MATTER OF AN APPEAL TO THE APPOINTED PERSON

BY SAIC MOTOR CORPORATION LIMITED

AGAINST A DECISION OF ALLAN JAMES

DATED 27 JUNE 2023

DECISION

Introduction

1. This is an appeal from a decision of Allan James, acting for the Registrar, dated 27 June 2023, in relation to consolidated revocation proceedings filed by Morris Commercial Limited (“**the Respondent**”) against seven UK Trade Mark registrations and an International Trade Mark registration owned by SAIC Motor Corporation Limited (“**the Appellant**”), in which the registrations were revoked for non-use.
2. The trade marks concerned are set out in the following table (the goods shown in bold are those which were the subject of the appeal):

<i>Trade mark</i>	<i>Date of registration/ protection in UK</i>	<i>Goods/services</i>
MORRIS UK439845	14/08/1923	Class 12: Motor cars and motor-chassis; but not including platform trucks propelled by electric batteries and trucks fitted with mechanical means for lifting, lowering and handling the load.
MORRIS UK477782	14/02/1927	Class 7: Parts of engines for motor cars. Class 12: Engines and gearings for motor cars and motor car chassis and parts thereof.
MORRIS UK477783	14/02/1927	Class 6: Locks, lock mechanisms, lock covers, boxes, badges, emblems, signs, nameplates, identification plates, cocks (valves), tubes, pipes, piping, brackets, screws, nuts, bolts; washers, clips, fasteners, pins for engineering use, binges, springs, cables, and hooks, all being components, parts and fittings of metal for motor cars and motor car chassis. Class 7: Electric ignition sparking plugs and piston rings, all being components, parts and fittings of metal for motor cars.

		<p>Class 9: Electric contacts and terminals; electrical cutouts; electric switches; all being components, parts and fittings of metal for motor cars and motor car chassis.</p> <p>Class 11: Lamps; reflectors for lamps and lights; all being components, parts and fittings of metal for motor cars and motor car chassis.</p> <p>Class 12: Components, parts and fittings for motor car chassis, all being metal.</p> <p>Class 17: Gaskets of metal being components, parts and fittings for motor cars and motor car chassis.</p>
MORRIS UK583123	28/01/1938	Class 7: Marine internal combustion engines and internal combustion engines for industrial machinery and parts of such engines; but not including engines and parts thereof for lifting, lowering and conveying machinery.
MORRIS MINOR UK1582199	18/08/1994	Class 25: Articles of outerclothing, footwear, T-shirts, boxer shorts, and ties; all included in Class 25.
MORRIS MINOR UK2006310	8/12/1995	Class 12: Motor cars; parts and fittings for motor cars; shaped or fitted mats for motor cars; shaped covers for motor cars and for motor car seats.
MORRIS MINOR UK2012466	29/03/1996	Class 28: Toys, games and playthings; scale model vehicles.
MORRIS GARAGES IR1174169	21/02/2014	Class 12: Automobile; wheels; hydraulic systems for vehicles; engines for land vehicles; coupling components for land vehicles; propulsion mechanism for land vehicles; shock absorbers for automobiles; vehicle chassis; transmission shafts for land vehicles; connecting rods for land vehicles, other than parts of engines; gear boxes for land vehicles; rear mirrors; windscreens; anti-theft devices for vehicles; interior decorations for automobiles; safety seat for children for land vehicles; repair outfit for inner tubes; tires for vehicles; brakes for

		<p>land vehicles; bodies for vehicles; caps for vehicles petrol tanks; couplings for land vehicles; shock absorbing springs for vehicles; direction signals for vehicles; vehicles for locomotion by land, air, water or rail.</p> <p>Class 37: Repair information relating to vehicles; installation and repair of heating equipment; installation, maintaining and repair of machines; installation and maintenance of illuminating apparatus; maintenance and repair of vehicles; vehicle service station for refueling and maintenance; installation and maintenance of entertainment or sports apparatus</p>
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3. The Hearing Officer decided that the evidence filed by the Appellant did not demonstrate genuine use of the trade marks during the relevant period 24 February 2017 to 23 February 2022, and accordingly revoked the trade marks on grounds of non-use with effect from 24 February 2022.

The Appeal

4. The Appellant filed a Notice of Appeal to the Appointed Person under s.76 of the Act. At the hearing before me, which was held remotely, the Appellant was represented by Daniel Selmi, instructed by HGF Limited, and the Respondent was represented by James St. Ville KC, instructed by Page, White & Farrer Ltd.

Standard of review

5. It is well established that in order to interfere with the decision of the Hearing Officer I must be satisfied that there was a distinct and material error of principle in the decision or that the Hearing Officer was wrong. The relevant principles were set out in *Axogen Corporation v Aviv Scientific Limited* [2022] EWHC 95 (Ch) at [24]. An appeal is by way of review, not a rehearing. Neither surprise at a Hearing Officer’s conclusion nor a belief that she or he has reached the wrong decision will justify interference. The decision of the lower court will be “*wrong*” if the judge makes an error of law, which might involve asking the wrong question, failing to take account of relevant matters or taking into account irrelevant matters. In the absence of an error of law, the appellate court would be justified in concluding that the

decision of the lower court was wrong if the judge's conclusion was "outside the bounds within which reasonable disagreement is possible" (*Actavis Group* at [80]). In the case of a multifactorial assessment or evaluation, involving the weighing of different factors against each other, the appeal court should show a real reluctance, but not the very highest degree of reluctance, to interfere in the absence of a distinct and material error of principle. Special caution is required before overturning such decisions (*TT Education v Pie Corbett Consultancy* [2017] RPC 17 at [52(iv)], *REEF Trade Mark* [2003] RPC 5 at [28] and *Fine & Country Ltd v Okotoks Ltd* [2014] FSR 11 at [50]-[51]).

6. In a recent trade mark appeal in *Stitch Editing Limited v. TikTok Information Technologies Ltd* [2023] EWHC 1167 (Ch), Sir Anthony Mann said at paragraphs [6] to [8]:

"6. The correct approach to appeals such as this has recently been confirmed in the decision of Richards J in Instagram LLC v Meta 404 Ltd [2023] EWHC 436 (Ch). In that case (which was another trade marks appeal case) the judge followed the guidance to be applied in appeals generally and set out in Volpi v Volpi [2022] EWCA Civ 464.

"i) An appeal court should not interfere with the trial judge's conclusions on primary facts unless it is satisfied that he was plainly wrong.

ii) The adverb "plainly" does not refer to the degree of confidence felt by the appeal court that it would not have reached the same conclusion as the trial judge. It does not matter, with whatever degree of certainty, that the appeal court considers that it would have reached a different conclusion. What matters is whether the decision under appeal is one that no reasonable judge could have reached.

iii) An appeal court is bound, unless there is compelling reason to the contrary, to assume that the trial judge has taken the whole of the evidence into his consideration. The mere fact that a judge does not mention a specific piece of evidence does not mean that he overlooked it.

iv) The validity of the findings of fact made by a trial judge is not aptly tested by considering whether the judgment presents a balanced account of the evidence. The trial judge must of course consider all the material evidence (although it need not all be discussed in his judgment). The weight which he gives to it is however pre-eminently a matter for him.

v) An appeal court can therefore set aside a judgment on the basis that the judge failed to give the evidence a balanced consideration only if the judge's conclusion was rationally insupportable.

vi) Reasons for judgment will always be capable of having been better expressed. An appeal court should not subject a judgment to narrow textual analysis. Nor should it be picked over or construed as though it was a piece of legislation or a contract."

7. So far as the decision below is evaluative, an appellate court should also approach the appeal with caution:

"76. So, on a challenge to an evaluative decision of a first instance judge, the appeal court does not carry out a balancing task afresh but must ask whether the decision of the judge was wrong by reason of some identifiable flaw in the judge's treatment of the question to be decided, "such as a gap in logic, a lack of consistency, or a failure to take account of some material factor, which undermines the cogency of the conclusion". (Re Sprintroom Ltd [2019] EWCA Civ 932)

8. And last, as Richards J observed in *Instagram*, proper respect should be paid to the decision of an expert tribunal in the field in question:

"26. Finally, it is relevant to observe that this is an appeal from a tribunal with particular expertise. As Lady Hale observed in AH (Sudan) v Secretary of State for the Home Department [2007] UKHL 49 at paragraph 30, the court should approach the appeal on the basis that it is probable that an expert tribunal, charged with applying the law in their specialist field, has probably got it right."

7. I have borne those principles firmly in mind.

Grounds of Appeal

8. The original Notice of Appeal did not comply with rule 71(1) of the Trade Mark Rules 2008 because it did not clearly set out the Appellant's grounds of appeal and its case in support of the appeal. In particular, although it appeared from the Notice of Appeal that the appeal related to all eight of the trade marks referred to above, there were no references to particular paragraphs of the Decision so that it was not possible to understand which aspects of the Decision related to the reasons set out in the single paragraph of the Notice of Appeal. I therefore directed the Appellant to file an amended Form TM55P setting out its grounds of appeal and its case in support *"in such a way that it is clear to which of the trade mark(s) and the relevant specification within each applicable class of each such trade mark each ground of appeal is directed"*. The Respondent was then given the opportunity to file an Amended Respondent's Notice.
9. Mr St. Ville KC submitted on behalf of the Respondent at the hearing before me that the amended Notice of Appeal still failed to refer to any paragraphs of the Decision, and included new assertions of fact. Mr St. Ville also argued that the original Notice of Appeal had been limited to the MORRIS trade marks, so that it was not open to the Appellant to include the MORRIS MINOR and MORRIS GARAGES trade marks in its Amended Grounds of Appeal. Mr Selmi in turn argued that the Respondent was seeking to introduce new grounds of cross-appeal at the hearing which had not been included in its Amended Respondent's Notice. The Appellant dropped some of its arguments at the hearing before me which had been included in the Amended Notice of Appeal, so that the appeal was ultimately based on

just two related grounds of appeal. For reasons which will become apparent, I am content to proceed on the basis of the content of the Amended Notice of Appeal, the Amended Respondent's Notice and the parties' skeleton arguments without objecting to any aspect of them. It is a matter, however, which is of relevance on the question of costs.

10. Only the class 12 goods shown in bold in paragraph 2 above were the subject of the appeal.
11. The Appellant had relied on a short (2 page) witness statement of Graham Payne with 13 supporting exhibits at the hearing before the Hearing Officer. Mr Payne was the Managing Director of British Motor Heritage Ltd ("**BMH**"), which had entered into a trade mark licence with the Appellant's predecessor in title. Exhibit 5 was BMH's Parts Guide and Price List from 2018. Mr Payne explained that BMH had, since at least 2001, either directly or through its licensees, supplied parts and components for classic British cars, including various MORRIS models. The front cover and contents page of the Parts Guide and Price List bore the prominent words "*British Motor Heritage*", together with a distinctive logo belonging to BMH. The contents page listed the brands for which BMH provided replacement parts, which did not include MORRIS, but included MINI. Mr Payne explained that between 1959 and 1969 a significant proportion of Mini cars were badged as MORRIS MINI. One of the pages showed MINI bodyshells, which did not bear any trade marks.
12. The Hearing Officer said this of Mr Payne's evidence in paragraph 31 of the Decision:

"The obvious problem with this part of Mr Payne's evidence is that it simply shows that BMH sell replacement bodyshells and body parts for MORRIS MINORS and MINIs, some of which may have been originally badged as MORRIS MINI. It does not show use of MORRIS by BMH to identify the trade source of the replacement bodyshells/parts. The mere fact the parts can be used for vehicles originally marketed as MORRIS cars is therefore irrelevant."

13. However, Mr Payne's evidence went on to state:

"... all parts we sell are sold with a British Motor Heritage label bearing a range of the licensed Trade Marks including the Morris logo. A photograph of a part bearing a BMH label is attached as exhibit Morris 12."

14. This photograph of the label was reproduced in paragraph 33 of the Decision as follows:



The Morris logo was the first logo on the second row of logos shown on the right hand side of the label.

15. The Hearing Officer found in paragraph 34 of the Decision that this label constituted licensed use of the trade marks shown on the right of the label to identify the trade source of the parts to which it was attached. The Respondent took issue with that finding (albeit submitting that it was obiter, given the Hearing Officer's findings of fact which will be discussed under Ground 2 below), arguing that the logos were simply being used to identify the makes of cars which the part was suitable to be used on, and that the trade source shown on the label was in fact BMH.
16. Since the Respondent had not challenged the truth of Mr Payne's evidence, or sought to cross-examine him, the Hearing Officer accepted his evidence that the label was attached to all the parts sold by BMH. However, he continued as follows:

"38. However, as the Appointed Person pointed out in Extreme Trade Mark, this does not mean that Mr Payne's evidence must be accepted uncritically. Although the truth of his statement is accepted, the appropriate weight to be afforded to his evidence must be assessed from the specificity, sufficiency, consistency, and all other aspects that together determine its probative value. Unfortunately, Mr Payne does not define what he means by 'the MORRIS logo' (other than by referring to the picture in exhibit 12). Contrary to Mr Selmi's submission, it is not 'plain' from simply looking at the photograph in exhibit 12 that the MORRIS logo shown there is the same as the logo shown in the Brand Deck document, i.e. that it includes the word MORRIS.

39. It is difficult to understand how a party trying to show use of MORRIS as a trade mark can end up relying on a photograph of a label so small that all one can see is a squiggle where the word MORRIS is supposed to be. This leaves me in the position of having to make the best I can of the evidence available. In doing so, I keep in mind that it is necessary to consider the evidence as a whole. Therefore, a deficiency in one aspect of the evidence can be compensated for by other aspects of the evidence, provided that when taken together the

evidence establishes the relevant fact to the standard required by the law. In civil proceedings this is the balance of probability.

40. I note that a label very similar to one shown in exhibit 12 is shown on page 6 of the 2018 Parts Guide and price list at exhibit 5. Unfortunately, the picture of the label is again very small and it is no easier to make out if the word MORRIS is present at the base of the MORRIS logo shown there. I observe that neither representation clearly includes the solid banner on which the word MORRIS appears in the version of the logo shown in the Brand Deck document.

41. Looking through the rest of the evidence, I note that the final page of the 2018 Parts Guide and price list includes an acknowledgement that “trademarks used in this publication are covered by appropriate licensing agreements or other agreements with their respective owners.” The trade marks in question, including the MORRIS logo, are shown below that statement. The MORRIS logo shown on that page looks like the one shown at paragraph 35 above, i.e. with the word MORRIS on a banner at the base of the logo. Exhibit 11 consists of an undated catalogue issued by Newton Commercial entitled MORRIS MINOR TRIM. According to the introduction page, Newton Commercial is approved by BMH as a trim manufacturer. I note that the Morris logo (again including the word MORRIS) appears on that page and also on page 23.

42. On the other hand, exhibit 8 consists of a Parts Catalogue from the David Manners Group which operates a Morris Minor Centre in Birmingham. Mr Payne says this is one of its ‘Approved Specialists’. It appears to provide a comprehensive range of parts for Morris Minors and a range of other classic cars. I note that the front cover of the catalogue contains a version of the MORRIS logo that looks like this:



43. This suggests there are different versions of the MORRIS logo, not all of which include the word MORRIS. Therefore, given that I cannot see the word MORRIS in the picture of the label Mr Payne says is attached to the parts BMH sells, I am unable to accept that the word MORRIS appeared on that label during the relevant period.”

17. The Appellant submitted that the Hearing Officer was wrong to conclude that the word Morris did not appear on the Morris logo shown in the photograph of the label above. That issue was Ground 2 of the appeal. Ground 1 of the appeal was that the Hearing Officer had wrongly dismissed evidence in respect of the Parts Guide and Price List referred to in paragraph 41 of the Decision. By the time of the hearing before me, the Appellant’s appeal was limited to how the Hearing Officer should have considered that Parts Guide and Price List together with the Morris logo which appeared on the label at exhibit 12. The Appellant

submitted that, had the Hearing Officer correctly found that the word Morris did appear on the logo on the label, he should not have dismissed the evidence shown in the Parts Guide and Price List at exhibit 5. This was because he had found that every part sold by BMH bore the label, and he had also found that that label amounted to trade mark use of the Morris logo. That would have amounted to genuine use of the word Morris in respect of all types of parts for vehicles, and would have amounted to use not only of the MORRIS trade marks but also of the MORRIS MINOR and MORRIS GARAGES trade marks too, with the Morris logo being an acceptable variant of those trade marks.

18. Since Ground 1 is dependent on the Appellant succeeding on Ground 2, I will consider Ground 2 first.

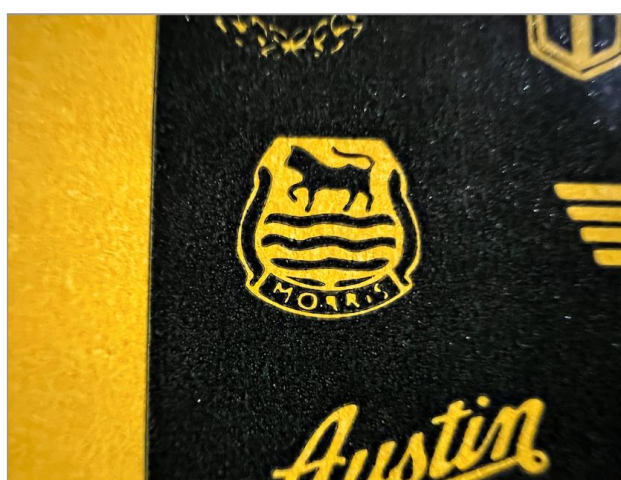
Ground Two: The Hearing Officer erred in his finding as to what the label showed

19. The Appellant's skeleton argument for the hearing before the Hearing Officer showed an enlarged image of the Morris logo, next to what was described as "*its corresponding image*" shown below right:



20. The Appellant criticised the Hearing Officer for identifying another logo which appeared in the parts catalogue from the David Manners Group, shown in paragraph 41 of the Decision as referenced above, and concluding that there were different versions of the Morris logo, not all of which included the word MORRIS. It was the Appellant's case that the Morris logo on the label clearly had "*something*" at the bottom, unlike the David Manners logo, and that "*that something was clearly legible in a number of places in the Appellant's evidence*", being the word MORRIS.
21. Without prejudice to its contention that the Morris logo on the label showed the word MORRIS when the evidence was construed as a whole, the Appellant applied at the hearing before me to rely on fresh evidence which took the form of an Annex to Mr Selmi's skeleton

argument, which was served two days before the hearing. The Annex was said to comprise higher resolution photographs of the label. These are shown below:



22. The principles to be applied when considering the admission of fresh evidence on appeal were summarised by Carr J in *Consolidated Developments v Cooper "Tin Pan Alley"* [2018] EWHC 1727 (Ch) as follows:

"23. The cases to which I have referred establish the following principles in respect of the admissibility of fresh evidence in trade mark appeals, sought to be introduced for the first time on appeal:

- i) the same principles apply in trade mark appeals as in any other appeal under CPR part 52. However, given the nature of such appeals, additional factors may be relevant;*
- ii) the Ladd v Marshall factors are basic to the exercise of the discretion, which are to be applied in the light of the overriding objective;*
- iii) it is useful to have regard to the Hunt-Wesson factors;*
- iv) relevant factors will vary depending on the circumstances of each case. Neither the Ladd v Marshall factors nor the Hunt-Wesson factors are to be regarded as a straightjacket;*

v) the admission of fresh evidence on appeal is the exception and not the rule;

vi) the Gucci decision does not establish that the Court or the Appointed Person should exercise a broad remedial discretion to admit fresh evidence on appeal so as to enable the appellant to re-open proceedings in the Registry; and

vii) where the admission of fresh evidence on appeal would require that the case be remitted for a rehearing at first instance, the interests of the parties and of the public in fostering finality in litigation are particularly significant and may tip the balance against the admission of such evidence.”

23. The *Ladd v Marshall* factors were those laid down by Lord Denning in *Ladd v Marshall* [1954] 1 WLR 1489 as follows:

“i) it must be shown that the evidence could not have been obtained with reasonable diligence for use at the trial;

ii) the evidence must be such that, if given, it would probably have an important influence on the result of the case, though it need not be decisive; and

iii) the evidence must be such as is presumably to be believed, or in other words, it must be apparently credible, though it need not be incontrovertible.”

24. The *Hunt-Wesson* factors were identified by Laddie J in *Hunt-Wesson Inc.'s Trade Mark Application* [1996] R.P.C 234 as follows:

“i) whether the evidence could have been filed earlier and, if so, how much earlier;

ii) if it could have been, what explanation for the late filing had been offered to explain the delay;

iii) the nature of the mark;

iv) the nature of the objections to it;

v) the potential significance of the new evidence;

vi) whether or not the other side would be significantly prejudiced by the admission of the evidence in a way which could not be compensated, e.g. by an order for costs;

vii) the desirability of avoiding multiplicity of proceedings; and

viii) the public interest in not admitting onto the register invalid marks.”

25. Applying those principles to the present case, the Appellant has not established the requisite criteria for me to allow the fresh evidence.

26. Firstly, no witness statement was filed in support of the application. The “evidence” was merely annexed to Mr Selmi’s skeleton argument.
27. Secondly, no explanation was given as to why this evidence was only being adduced for the first time two days before the hearing of the appeal, or why it could not have been obtained before and relied on at the hearing before the Hearing Officer.
28. Thirdly, there was no explanation of what the evidence was, other than it was said by Mr Selmi to be two high resolution photographs of the label. However, the evidence was not better copies of the same photograph which appeared in the evidence and which the Hearing Officer reproduced in paragraph 33 of his Decision. This is clear as the label in paragraph 33 features the words “RH Upper Tonneau Side Panel” whereas the fresh evidence showed a label featuring the words “Bumper Fixing Reinforcement”, as well as a different serial number, suggesting it was a label affixed to a different part. The fresh evidence was undated. I assume the close up view of the Morris logo is a zoomed in image of the first photograph showing the whole label, but there was no statement confirming that that was the case.
29. The late filing of this evidence deprived the Respondent of any opportunity to examine the evidence or cross-examine a witness about it. For example, there was no indication of the size of the label from the photograph of it, in order to form a view as to whether the average consumer would notice or be able to make out the word MORRIS on that label.
30. Finally, it is not clear whether the logo as it appears in the close up photograph in the fresh evidence is the same logo as that shown on the Morris logo in paragraph 33 of the Decision. For example, the fresh evidence shows a black curved rectangular banner behind the word MORRIS written in yellow type, whereas the close up of the Morris logo shown in paragraph 19 above appears to show “something” in dark type against a yellow background, with no sign of a curved dark rectangular banner. Similarly, there is no border around the edge of the logo in the fresh evidence, whereas there is a suggestion of a dark border around the shield shape of the Morris logo in the close up in paragraph 19 above.
31. I have therefore based my decision on the second ground of appeal without taking into account the fresh evidence.
32. The Appellant accepted that the word MORRIS is not visible in the photograph shown in paragraph 33 of the Decision. However, it argued that the Hearing Officer should have come to the conclusion that the “something” which appears at the bottom of the Morris logo must

be the word MORRIS because the word MORRIS appears in that position on other logos featured in the evidence, which it said were the same as the Morris logo.

33. In particular, the Appellant relied on the right hand logo shown at paragraph 19 above, which was taken from a “Brand Deck” document, and also appeared on the last page of the Parts Guide and Price List at exhibit 5, and on two of the pages of an undated catalogue at exhibit 11. That logo clearly features different colours to the two-tone yellow and black logo shown on the label, and itself appeared in different colourways in the evidence – for example, appearing as shown below in exhibit 11, featuring black rather than blue colouring:



The horseshoe-shaped white arms on either side of the shield device are also closer to the edge of the shield than the dark horseshoe-shaped arms which appear on the Morris logo on the label. It also features a curved rectangular banner behind the word MORRIS which is not apparent on the Morris logo on the label. This was pointed out by the Hearing Officer when he referred to the label shown below which appeared in the Parts Guide and Price List at exhibit 5:



The Hearing Officer said that it was no easier to see whether the word MORRIS appeared at the base of the first logo which appears on the second line on the right of the above label than it was for the label in exhibit 12. However, he did observe that this logo, as with the Morris logo shown on the label in exhibit 12, did not appear to have *“the solid banner on which the word MORRIS appears in the version of the logo shown in the Brand Deck Document”*.

34. As noted in paragraph 20 above, the Hearing Officer had also identified another logo, used in the David Manners catalogue, which did not include the word MORRIS at all. Exhibit 10, which was another catalogue from a different company described by Mr Payne as a “*BMH approved specialist supplying “Morris” parts*”, also featured the logo shown below, which appears to have the word MORRIS outside of the shield device, and a different shaped shield to the Morris logo on the badge:



as well as these two logos, which appear to be different again:



35. It is therefore clear that there were several different logos used in relation to Morris vehicles. The Hearing Officer did not fall into error by identifying that the evidence showed different forms of logo, and that as a result, he could not be sure that the logo which appeared on the label in exhibit 12 must have been the same logo as the one shown on the right in paragraph 19, as opposed to any other logo which may have been used in respect of Morris vehicles which did not feature the word MORRIS. He was careful to consider the position in light of the whole of the evidence which had been provided, but also taking into account evidence that was not provided but could have been, saying as follows in paragraph 56 of the Decision:

“56. Thus far I have looked at the evidence which has been filed. However, as Mr Alexander made clear in Awareness v Plymouth City Council, it is necessary to

evaluate this evidence against the background of the material that should have been available to the proprietor, but which has not been provided. This includes:

(1) Clear (and legible) examples of MORRIS being used to guarantee the trade source of car parts;

(2) Evidence from BMH's Approved Specialists as to how they used MORRIS under licence as a trade mark for parts for cars during the relevant period (if they did);

(3) Invoices showing sales of MORRIS parts;"

36. There was no suggestion that the Hearing Officer misstated the principles of law to be applied when assessing genuine use, which he set out accurately in paragraphs 9 to 12 of his Decision. In particular, he cited the following well-known extract from *Awareness Limited v Plymouth City Council* Case BL O/236/13 where Daniel Alexander KC, as the Appointed Person, said:

"22. The burden lies on the registered proprietor to prove use..... However, it is not strictly necessary to exhibit any particular kind of documentation, but if it is likely that such material would exist and little or none is provided, a tribunal will be justified in rejecting the evidence as insufficiently solid. That is all the more so since the nature and extent of use is likely to be particularly well known to the proprietor itself. A tribunal is entitled to be sceptical of a case of use if, notwithstanding the ease with which it could have been convincingly demonstrated, the material actually provided is inconclusive. By the time the tribunal (which in many cases will be the Hearing Officer in the first instance) comes to take its final decision, the evidence must be sufficiently solid and specific to enable the evaluation of the scope of protection to which the proprietor is legitimately entitled to be properly and fairly undertaken, having regard to the interests of the proprietor, the opponent and, it should be said, the public."

37. Earlier in the same case, Daniel Alexander KC also said at [19]:

"For the tribunal to determine in relation to what goods or services there has been genuine use of the mark during the relevant period, it should be provided with clear, precise, detailed and well-supported evidence as to the nature of that use during the period in question from a person properly qualified to know. Use should be demonstrated by solid and objective evidence of effective and sufficient use of the trade mark on the market concerned ..."

38. I therefore agree with the Hearing Officer's comments at the start of paragraph 39 of the Decision where he said:

"It is difficult to understand how a party trying to show use of MORRIS as a trade mark can end up relying on a photograph of a label so small that all one can see is a squiggle where the word MORRIS is supposed to be."

39. I find that the Hearing Officer's conclusion that he could not accept that the word MORRIS appeared on the label in exhibit 12 during the relevant period was one which a reasonable

tribunal could have reached, faced with the evidence before the Hearing Officer, and was not rationally insupportable. As such, the appeal fails under Ground 2.

Conclusion

40. Since, as I explained in paragraph 18 above, the Appellant's Ground 1 was dependent on it succeeding under Ground 2, it is not necessary for me to go on to consider Ground 1 or the Respondent's cross-appeal.
41. The appeal fails and is dismissed.

Costs

42. Since the appeal has been dismissed, the Respondent is entitled to a contribution towards its costs of the appeal. The Respondent had to file an Amended Respondent's Notice in addition to its original Respondent's Notice as a result of the Appellant serving an Amended Notice of Appeal. In addition, the Appellant changed its case in its skeleton argument, and again at the hearing before me, dropping parts of its case which Mr St. Ville submitted he had had to prepare for in readiness for the hearing before me. In addition, there was the last minute application to adduce fresh evidence which the Respondent had to respond to. Although I do not consider that off-scale costs are appropriate, I do consider that the Respondent is entitled to a higher than usual costs award in recognition of the amount of work it was required to undertake as a result of the Appellant's conduct on the appeal. I therefore make an order that the Appellant pays to the Respondent a contribution of £2,800 towards the costs of the appeal, in addition to the award of £5,100 ordered to be paid by the Hearing Officer, making a total of £7,900 to be paid within 21 days of the date of this decision.

Simon Clark
The Appointed Person
4 July 2024

Representation:

Appellant: Daniel Selmi, instructed by HGF Limited
Respondent: James St. Ville KC, instructed by Page, White & Farrer Limited